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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 09/704,134 | 11/01/2000 | Todd Siegel | 00688081 | 4080 |
| 33448 | 7590 | 10/05/2005 | EXAMINER | |
| ROBERT J. DEPKE LEWIS T. STEADMAN TREXLER, BUSHNELL, GLANGLORGI, BLACKSTONE & MARR 105 WEST ADAMS STREET, SUITE 3600 CHICAGO, IL 60603-6299 | | | PARADISO, JOHN ROGER | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3721 | |

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,134

Applicant(s)

SIEGEL ET AL.

Examiner

John R. Paradiso

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/14/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/15/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over TAKEMASA ET AL (US 5765606) in view of BOUTHINETTE (US 6023916) and HAYES ET AL (US 6334980), as set forth in paragraph 3-12 of the previous Office Action.

Regarding claims 2 and 7, Examiner gave Official Notice that the use of pneumatic cylinders for movement of machine assemblies is notoriously well known in the art. Absent any argument from Applicant, Examiner henceforth considers this to be admitted prior art.

Response to Arguments

3. Applicant's arguments filed 7/14/2005 have been fully considered but they are not persuasive.

4. Applicant states on page 2 of his Response that "Applicant again respectfully submits that the Hayes reference is non-analogous art." On page 3, Applicant continues "Applicant respectfully submits that, consistent with *In re Oetiker*, in the present case, it can not be said that a person of ordinary skill in the art, seeking to solve the problem of packaging solid

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pharmaceuticals, would reasonably be expected or motivated to look to an apparatus of conducting biochemical reactions.”

However, as stated in the Final Rejection mailed 5/4/2004, it is misleading to say that HAYES ET AL is merely an apparatus for conducting research and analysis without examining the structure and functions disclosed therein. In particular, HAYES ET AL shows a dispensing apparatus (602a-c) which dispenses specific quantities of fluid to specific places on a template (722) which is moved by an X-Y positioning table (606). An X-Y (608) moves the positioning table so that the correct spots in the template are positioned under the correct dispensers. (See HAYES ET AL column 11:38-12:19 and figure 9.) Accordingly, Examiner maintains the rejection detailed above.

5. Applicant states on page 5 of his Response that “In the present case, the Examiner has not identified any suggestion or incentive to combine the references indicated in the Office Action, other than referring to the invention itself.”

However, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Examiner stated the motivations for combining the references in paragraphs 7 and 10 of the previous Office Action:

“It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of TAKEMASA ET AL by

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dispensing the pharmaceutical products into product package templates, as taught by BOUTHINETTE, in order to ensure facilitated product placement into popular compartmented containers.”

“It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the X-Y positioning table, as taught by HAYES ET AL, in the combination of TAKEMASA ET AL and BOUTHINETTE in order to more accurately place the products.”

Since both ensuring good product placement in containers and accurately placing the products in a compartmented tray are motivations that would occur to one of ordinary skill in the art, Examiner maintains the rejections.

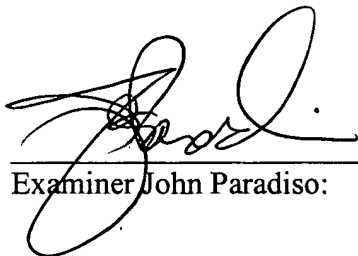
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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.



Examiner John Paradiso: (571) 272-4466

Additional Phone Numbers:

Supervisor Rinaldi Rada: (571) 308-7135

Fax (Official): (571) 273-8300

Fax (Direct to Examiner) (571) 273-4466 (Drafts only)



September 27, 2005

Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700